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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,587	09/27/2001	Sundar J. Rajan	54676US002	2684
32692	7590	12/13/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			CHEVALIER, ALICIA ANN	
PO BOX 33427			ART UNIT	
ST. PAUL, MN 55133-3427			PAPER NUMBER	
			1772	
DATE MAILED: 12/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/937,587	Applicant(s) RAJAN ET AL.	
	Examiner Alicia Chevalier	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-37 is/are pending in the application.
- 4a) Of the above claim(s) 20-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-19 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/26/04</u> | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Claims 1-4 and 7-37 are pending in the application, claims 20-36 are withdrawn from consideration. Claims 5 and 6 have been cancelled.
2. Amendments to the claims, filed on September 27, 2005, have been entered in the above-identified application.

REJECTIONS

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 112

4. Claims 1-4, 7-19 and 37 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Newly Amended claims 1, 18 and 19 now recite “an exposed surface comprising a radiation cured coating,” which is unclear and renders the claims vague and indefinite. First the claim does not claim that the radiation cured coating is the outer most layer. So is the layer exposed to another layer or is it exposed to air? This limitation is unclear due to the fact the structure relationship between the layers is not defined in the claims.

Claim Rejections - 35 USC § 102

5. Claims 1-4, 7-19 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Lu (U.S. Patent No. 5,670,096).

Lu discloses a signage article (*retroreflective article, title*) comprising a substrate (*array microlenses, col. 5, line 25 and figure 2*) comprising a noncellulosic organic polymer surface (*col. 9, lines 20-34*), a radiation cured coating (*spacing layer, col. 5, line 25 and figure 2*) cross linked by exposure radiation selected from the group consisting of ultraviolet radiation, visible radiation, electron beam radiation, and combinations thereof disposed on the noncellulosic organic polymeric surface (*col. 7, lines 53-66 and claim 2*) and a marking material (*ink, col. 5, lines 39-40*) disposed on the radiation cured coating (*figure 2*). The radiation cured coating is deemed to be an exposed surface, since it is exposed to the marking (*figure 2*).

In the instant case, Lu does not explicitly teach the properties wherein the marking material is not substantially removed from the signage article upon wiping the marking material with gasoline for five cycles, ten cycles, or twenty cycles, upon abrading the marking material for 1000 scrub cycles, or upon applying a pressure sensitive adhesive-coated tape to the marking material under thumb pressure and removing it. Also, Lu does not explicitly teach the properties wherein the radiation cured coating is not substantially removed from the signage article upon wiping the marking material with gasoline for five cycles, upon abrading the marking material for 1000 scrub cycles, or upon applying a pressure sensitive adhesive-coated tape to the marking material under thumb pressure and removing it.

However, it has been held that where claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially

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identical processes, a *prima facie* case of either anticipation has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC 102. Therefore, the *prima facie* case can be rebutted by *evidence* showing that the prior art products do not necessarily possess the characteristics of the claimed product. MPEP 2112.01.

Therefore, in addition to the above disclosed limitations, the presently claimed properties would have inherently been present because Lu discloses the same materials used for the radiation cured coating (*i.e. acrylates, col. 9, lines 11-19*) and the marking material (*ink, col. 5, lines 39-40*). MPEP 2112.01

The substrate comprises a noncellulosic organic polymeric surface comprising a retroreflective sheeting (*col. 7, lines 41-66*).

The retroreflective sheeting is deemed to be part of a validation sticker, since the retroreflective sheet, *i.e.* base sheet, is adhesively adhered to the surface of a document (*col. 5, lines 42-44*).

The marking material may comprise a second ink formulations comprising a colorant and a binder and the binder comprises a polymer selected from the group of a polyester, a vinyl, a polyolefin, a polyvinyl acetal, an alkyl or aryl substituted acrylate or methacrylate, a copolymer of ethylene or propylene with acrylic acid, methacrylic acid, or vinyl acetate, and combinations thereof (*col. 13, lines 1-6*).

The uv-curable composition comprises an acrylate (*col. 9, lines 11-19*).

The limitation “radiation cured coating is pattern coated” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results.

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The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Lu discloses a radiation cured coating on a substrate.

The signage articles does not include a protective coating over the material (*figure 2*).

The signage article is a product authentication article (*col. 2, lines 40-41*).

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments in the responses filed June 29, 2005 and September 26, 2005 regarding the previous rejections of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the amendment made to the claims is believed to overcome the rejections. The examiner disagrees for reasons above in the rejections.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

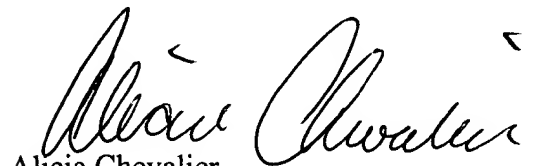
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alicia Chevalier
Primary Examiner
12/9/05

**ALICIA CHEVALIER
PRIMARY EXAMINER**